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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Holophane Corporation

Serial No. 75/298,577

Paul M. Schwartz and Maria Franek Angileri for Holophane Corporation.

Vivian M. First, Trademark Examining Attorney, Law Office 104
(Sidney I. Moskowitz, Managing Attorney).

Before Hohein, Hairston and McLeod, Administrative Trademark Judges.

Opinion by Hohein, Administrative Trademark Judges:

Holophane Corporation, a Delaware corporation with a location in Newark, Ohio, has filed an application to register the term "MILAN" as a trademark for goods identified as "heavy-

duty electric lighting fixtures for outdoor architectural lighting".¹

Registration has been finally refused under Section 2(e)(3) of the Trademark Act, 15 U.S.C. §1052(e)(3), on the ground that applicant's mark is primarily geographically deceptively misdescriptive of applicant's goods.

Applicant has appealed. Briefs have been filed but an oral hearing was not requested. We reverse the refusal to register.

In order to establish a *prima facie* case for refusal on the ground that a mark is primarily geographically deceptively misdescriptive of an applicant's goods within the meaning of Section 2(e)(3) of the statute, the Examining Attorney must show that the primary significance of the mark is a generally known geographic place; that purchasers would be likely to think that the goods originate in the geographic place identified by the mark, that is, purchasers would make a goods/place association; and that the goods do not in fact originate in the place identified by the mark. See, e.g., *In re Wada*, 194 F.3d 1297, 52 USPQ 1539, 1540 (Fed. Cir. 1999); *In re Societe Generale des Eaux Minerales de Vittel S.A.*, 824 F.2d 957, 3 USPQ2d 1450, 1452 (Fed. Cir. 1987); *In re Loew's*

¹ Ser. No. 75/298,577, filed on May 27, 1997, which alleges a bona fide intention to use such term in commerce.

Theatres, Inc., 769 F.2d 764, 226 USPQ 865, 867 (Fed. Cir. 1985); and In re Nantucket, Inc., 677 F.2d 95, 213 USPQ 889, 892-93 (CCPA 1982). However, "[a] mark is not primarily geographic where the geographic meaning is obscure, minor, remote, or not likely to be connected with the goods." In re Wada, supra, citing In re Nantucket, Inc., supra at 892.

Applicant argues that its "use of 'MILAN' is purely arbitrary and fanciful" and that its use thereof "is not [primarily] geographically deceptively misdescriptive because there is no proof that the purchasers would associate heavy-duty lighting fixtures with fashionable lighting from Milan, Italy." In particular, applicant insists that:

As the evidence of record demonstrates, the applicant manufactures and distributes heavy-duty electric lighting fixtures for outdoor architectural lighting. These fixtures are neither promoted nor sold to retail customers nor are they part of the fashion world for which Milan, Italy, is famous. The applicant provides lighting fixtures and systems specifically for outdoor architectural projects such as highways, roadways, parking lots, and the like. The applicant's fixtures are purchased by knowledgeable, technically astute engineers, architects, and city planners who are more interested in function, including weather resistance and photometric performance, than artful design.

The applicant has been in the business of manufacturing and distributing heavy-duty lighting fixtures for commercial and

industrial applications since 1896. Based in Columbus Ohio, the applicant has maintained a national and international reputation for highly engineered, premium quality heavy-duty lighting fixtures for over 100 years. As indicated above, buyers of the applicant's heavy-duty lighting fixtures ... are intimately familiar with the applicant, its location and reputation. Notwithstanding the fact that the applicant's use of the mark "MILAN" is arbitrary, it is not likely--indeed it is highly unlikely--that such buyers will in any way believe that the ... lighting fixtures originated in Milan. To the contrary, such buyers are well aware that the applicant's products originate from the same place they have come from for the last century--Columbus, Ohio.

In addition, while stating that it "does not disagree with the examiner's argument that Milan is frequently referred to [as] a 'fashion capital' of the world," applicant contends that the mere fact that its product specification literature "refers to its fixtures as 'Euro styled luminaries'" does not "imply that the applicant's fixtures originated in Milan" as asserted by the Examining Attorney. According to applicant, "it is highly unlikely that sophisticated engineers, architects, and city planners will in any way believe that the ... light fixtures originated in Europe, much less Milan, a fashion capital of the world, [just] because the applicant's goods are referred to as 'Euro styled luminaires' in the ... product specifications."

Lastly, although applicant makes no mention of the fact that the excerpts furnished by the Examining Attorney from her searches of the "NEXIS" database show that Milan, Italy is home to luminaire factories and to "Euroluce," a bi-annual trade show for electric lighting products, applicant urges, in light of the "NEXIS" excerpts of record demonstrating that such city is known as one of the fashion capitals of the world with respect to clothing, that it would be "beyond belief" for purchasers "to associate the applicant's heavy-duty lighting fixtures with the fashion industry in Milan, Italy." Applicant therefore concludes that "[b]ecause there is no connection of geographical meaning of the mark with the goods in the public mind," the term "MILAN" is not primarily geographically deceptively misdescriptive.

The Examining Attorney, on the other hand, insists that such term is primarily geographically deceptively misdescriptive "because the public will believe that the goods for which the mark is sought to be registered originate in Milan, Italy, the place named in the mark." Noting that applicant admits, as stated in its July 20, 1998 response, that its "lighting fixtures are manufactured in Newark, Ohio, not Milan, Italy," and that the definition of record, from Webster's II New Riverside University Dictionary (1994) at 1486, lists "Milan" under the category of "Geographic Entries" as a city in

Northern Italy with a population of 1,634,638, the Examining Attorney asserts that "the evidence of record demonstrates that Milan, Italy is a location that is known for the manufacture and sale of lighting products."

In support of her position, the Examining Attorney contends that the following representative examples of "NEXIS" excerpts are sufficient to show that Milan, Italy "is associated with lighting products" to such an extent that purchasers would make "the necessary goods/place association" (**emphasis added**):²

² While we also note the following excerpt, it nevertheless is of limited probative value inasmuch as it is from a foreign publication which has not been shown to have a significant circulation in the United States (**emphasis added**):

"But the heart and soul of **contemporary industrial design remains firmly rooted in Milan** and in Northern Italy. There are numerous companies that produce and export all over the world - from office furniture to **lighting** and kitchenware, traditional fruits of this uniquely Italian combination of industry and aesthetics." - The Times, June 3, 1998.

As stated by the Board in *In re Men's International Professional Tennis Council*, 1 USPQ2d 1917, 1919-20 (TTAB 1986), "we cannot--absent other evidence--, infer that these foreign uses have had any material impact on the perceptions of the relevant public in this country." In the same vein, the Board indicated in *In re Bel Paese Sales Co.*, 1 USPQ2d 1233, 1235 (TTAB 1986), that articles in foreign publications "are of no probative value as to public perception in the United States since ... there is no evidence as to the extent of circulation of those publications in the United States, if any." In view thereof, the following excerpt, mentioned by the Examining Attorney in her brief, is likewise without probative value in this case (**emphasis added**):

"But then, they take **lighting** more seriously in Italy especially during EuroLuce, the **lighting** fair currently being held in **Milan**, the launchpad staged every other year for top names in **lighting**." -- The Independent (London), April 16, 1998.

"The big news here last spring was not furniture. It was **lighting**.

But it was a different story at Euroluce, the **lighting show** that pops up within the umbrella of the Salone every other year." -- Chicago Tribune, August 30, 1998 (article datelined "**Milan**" and headlined, in part, "**LIGHTING PRODUCTS OF ALL KINDS TURN MILAN ON**") ;

"Finally, 450 exhibitors attended Euroluce (**an exhibition of lighting equipment**, alternating with the Salone della Cucina)

....
The strength of the **Milan event** appears to consolidate each year" -- Cabinet Maker, May 22, 1998; and

"We've produced annual issues on resort, exterior, museum, and office **lighting** assignments; covered the trade show waterfront from Hanover, Germany, to Hong Kong; reported from sites such as the Atlanta Olympics and **luminaire factories in Milan**" -- Lighting Dimensions, October 1997;

In addition, while not specifically mentioned by the Examining Attorney, the following "NEXIS" excerpt would appear to have some relevance:

"**MILAN**, Italy--Italian **lighting** runs the gamut from period and modern designs to the famed blown glass Murano and Tuscany, but Euroluce '98 -- the first exhibition to use the new pavilions of the **Milan** fairground -- looked more like a science fair or an art gallery than a trade show." - HFW The Weekly Newspaper for the Home Furnishing Network, April 27, 1998.

Coupling the above evidence with other "NEXIS" excerpts showing that, with respect to the clothing design field, Milan, Italy is internationally recognized, like London, Paris and New York, as a fashion capital for such industry, the Examining Attorney asserts that Milan has been demonstrated to be "the European city that is a leader in lighting design fashion." In view thereof, and because "applicant's product literature highlights and emphasizes the geographic significance of the word 'MILAN' by describing the goods at issue as 'the Euro style luminaire,'" the Examining Attorney concludes that the requisite goods/place association would be made by applicant's customers because the product description in its literature "connects the goods of the applicant to Milan, Italy." As to applicant's contention that customers for its products would not believe that the goods originate in or are otherwise connected with Milan, Italy because they know that applicant has been in business in its Ohio location for over a century, the Examining Attorney argues that:

[I]t is common for a product to have its origin in several locations. For example, a lighting fixture could have components from Japan, a housing manufactured in the United States, and be designed by a famous European designer. Therefore, consumer familiarity with the location of applicant's business does not negate the geographic misdescriptiveness of the mark.

The record in this case plainly establishes that the first and third prongs of the test for whether a term is primarily geographically deceptively misdescriptive of the goods with which it is associated are satisfied in that the term "MILAN" has been shown to be the name of a generally known geographic place and applicant's lighting fixtures do not come from such place. We are constrained to agree with applicant, however, that the record does not support a conclusion that the second prong of the test, namely, that the purchasing public for applicant's goods would make a goods/place association such that they would believe that applicant's heavy-duty electric lighting fixtures for outdoor architectural lighting do in fact originate, in the sense that they are produced and/or designed, in Milan, Italy. Stated otherwise, the record simply does not show that engineers, architects and city planners, who constitute the bulk of the purchasers for applicant's goods, have reason to believe that such goods, when bearing or otherwise sold under the term "MILAN," come from the Italian city of Milan.

In this regard, we have not overlooked the fact that applicant's product specification literature, in addition to providing a "GENERAL DESCRIPTION" of its "OUTDOOR ARCHITECTURAL LIGHTING" as "The Euro styled luminaire," lists various models of its lighting fixtures under the names of the European cities

of "Vienna," "Milan," "Lyon" and "Prague," on one page thereof, and sets forth the name of the Swiss city of "Bern" on another page. Rather than being likely to cause applicant's customers to make a goods/place association with such geographical names, including the term "MILAN," we think that in context the use of those names would be merely evocative of a style of, or the ambiance created by, the architectural lighting fixtures found in those cities. Prospective purchasers and buyers of applicant's goods would not be likely to believe that, for example, the "MILAN" lighting fixture depicted is either made or has been especially designed in Milan, Italy any more than they would be by the reference in applicant's literature to its product as a "Euro styled luminaire."

Moreover, while the record shows that there are at least some luminaire factories in Milan and that such city hosts a major bi-annual electrical lighting trade show known as "Euroluce," such evidence is insufficient in our view to support a conclusion that customers for applicant's lighting fixtures would make a goods/place association of any kind, much less that they would regard Milan as "the European city that is a leader in lighting design fashion" as urged by the Examining Attorney. The fact, furthermore, that the city of Milan, Italy is undeniable a fashion capital with respect to clothing and the design thereof does not mean that the term "MILAN" signifies

fashionable or stylish goods of all types including, arguably, heavy-duty electric lighting fixtures for outdoor architectural lighting. Absent evidence, for instance, that Milan, Italy is prominently associated with the design of commercial and industrial products in general or lighting fixtures in particular, we must find on this record that actual and prospective customers for applicant's goods would not expect heavy-duty electric lighting fixtures for outdoor architectural lighting to originate in Milan, Italy when marketed under the term "MILAN". Accordingly, without adequate proof of a goods/place association between applicant's lighting fixtures and the term "MILAN," the refusal on the ground that such term is primarily geographically deceptively misdescriptive of applicant's goods cannot be upheld. See, e.g., In re Nantucket, Inc., supra at 894; and Philip Morris Inc. v. Reemtsma Cigarettenfabriken GmbH, 14 USPQ2d 1487, 1490 (TTAB 1990).

Decision: The refusal under Section 2(e)(3) is reversed.

G. D. Hohein

P. T. Hairston

Ser. No. 75/298,577

Judges,

Board

L. K. McLeod

Administrative Trademark

Trademark Trial and Appeal